

REMARKS

In the Office Action dated June 19, 2007, claims 18-21 were rejected under 35 U.S.C. § 101; claims 1, 11, 13, and 15-30 were rejected under § 102 over U.S. Patent Application Publication No. 2004/0176104 (Arcens); claims 7 and 8 were rejected under § 103 over Arcens in view of U.S. Patent No. 6,195,557 (Havinis); claims 3-5 were rejected under § 103 over Arcens and Havinis; claim 9 was rejected under § 103 over Arcens, Havinis and U.S. Patent Application Publication No. 2004/0180655 (Applicant's "admitted prior art"); and claims 12 and 14 were rejected under § 103 over Arcens in view of Applicant's "admitted prior art."

REJECTION UNDER 35 U.S.C. § 101

Claims 18-21 were rejected under § 101 because the Office Action asserted that “an article comprising ...” “is a nonfunctional descriptive material, and does not define any structural and functional interrelationships between the claimed elements which permit functionality to be realized.” 6/19/2007 Office Action at 2.

Applicant respectfully disagrees with this assessment, as claim 18 is related to an article of manufacture that includes at least one storage medium that contains instructions that when executed cause a mobile station to perform the recited tasks. Thus, there clearly exists both structural and functional interrelationships between the claimed elements and the underlying hardware, *i.e.*, the mobile station. Since claim 18 is directed to subject matter that provides a practical application, claim 18 recites statutory subject matter.

Therefore, reversal of the § 101 rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 102

Independent claim 1 was rejected as being anticipated by Arcens. It is respectfully submitted that the anticipation rejection is defective, as Arcens does not disclose communicating, to the mobile station, a *paging message* containing an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service. As disclosing the communication of such a paging message, the Office Action cited Fig. 1 (in particular the privacy engine 120) of Arcens, and ¶¶ [0021], [0041], and [0046]-[0047] of Arcens. Paragraph [0021] of Arcens refers to various components of the mobile station 102 depicted in Fig. 1. Paragraph [0041] refers to Fig. 2(a) of Arcens, in which step 204 of Fig. 2(a) refers to the privacy engine 120 receiving a position request “via the data connections described herein above with reference to Fig. 1.” However, the “position request” of Arcens cannot constitute the paging message of claim 1.

The Office Action has apparently ignored what a person of ordinary skill in the art would understand the term “paging message” to be. A person of ordinary skill in the wireless art would clearly understand that a position request as described in Arcens is not a paging message that is sent to a mobile station. In fact, claim 13, which depends from claim 1, separately recites a “position request.” Thus, based on the claims themselves, it is clear that a “paging message” is not the same as “position request.”

Moreover, the present Specification refers to various types of messages, including a position request as discussed in ¶ [0006], a position determination data message (PDDM) as discussed in ¶ [0024], and a paging message as described in ¶ [0027] of the Specification. Thus, it is clear that, in the phrase “paging message” as used in claim 1, the term “paging” was not intended to be a *meaningless* term, but rather specifies a type of message that is different from the other types of messages discussed.

In view of the foregoing, it is respectfully submitted that Arcens does not anticipate the subject matter of claim 1.

Independent claim 15 was also rejected as being anticipated by Arcens. Claim 15 recites a method that comprises receiving a *paging message* by a mobile station that is not on a traffic channel and that is configured to accept an emergency-related location service or a law enforcement-related location service, but not a value-added service location service, with the

*paging* message containing an indication that the paging message is related to at least one of the emergency-related location service and the law enforcement-related location service.

With respect to claim 15, the Office Action again cited to element 202 in Fig. 2(a) of Arcens, which refers to the privacy engine of Arcens receiving a position request. As discussed above in connection with claim 1, the position request of Arcens is not a paging message as recited in claim 15. Therefore, claim 15 is not anticipated by Arcens.

Independent claims 22 and 27 are also allowable over Arcens for similar reasons as those given above.

Independent claim 18 is also not anticipated by Arcens, since Arcens clearly fails to disclose receiving messaging to cause the mobile station to move to a traffic channel in response to a callback by at least one of an emergency services entity and a law enforcement entity (as recited in claim 18). As purportedly disclosing this element of claim 18, the Office Action cited element 202 in Fig. 2(a) of Arcens, where the Office Action stated that element 202 “represents a state during which the privacy engine 120 awaits reception of a request for location data information (*i.e.*, a position request).” 6/19/2007 Office Action at 6. Waiting for a position request does not “cause the mobile station to move to a traffic channel in response to a callback by at least one of an emergency services entity and a law enforcement entity,” as recited in claim 18. Therefore, claim 18 is clearly not anticipated by Arcens.

REJECTION UNDER 35 U.S.C. § 103

Independent claim 8 was rejected as being obvious over Arcens and Havinis. The obviousness rejection is defective for at least the reason that the Office Action has mis-applied Arcens to the “communicating a paging message” clause of claim 8. As discussed above, Arcens clearly does not disclose communicating a paging message to a mobile station, where the paging message contains an indication of whether the *paging* message is related to at least one of an emergency-related location service and a law enforcement-related location service.

In view of this mis-application of Arcens to an element of claim 8, the obviousness rejection is defective. Moreover, as conceded by the Office Action, Arcens does not disclose communicating the paging message by sending a paging request containing the indication from a mobile switching center to a base station. 6/19/2007 Office Action at 12. However, the Office Action cited Havinis as disclosing the claim feature that is missing from Arcens. Specifically, the Office Action cited to column 6, line 62-column 7, line 2 of Havinis.

Rather than support the obviousness rejection, Havinis actually supports Applicant’s argument that claim 8 is non-obvious over the cited references. In the cited passage of Havinis, reference is made to the serving MSC forwarding a positioning request to a base station controller. Column 7 of Havinis also notes that if the mobile station is in idle mode, then the serving MSC “must page the MS 300 and setup a call to the MS 300 *prior to forwarding the positioning request 382 to the BSC 340 (step 540).*” Havinis, 7:2-5 (emphasis added). There is absolutely no indication that the page of Havinis is anything other than a normal page from a serving MSC to the MS. If the Office Action is equating “positioning request” of Havinis with the “position request” of Arcens, then Havinis would have indicated to a person of ordinary skill in the art that the position request of Arcens cannot be communicated to a base station controller until the serving MSC first pages the MS. From this, it is clear that Arcens and Havinis would not have taught or hinted that a page can contain the indication recited in claim 8.

Since the hypothetical combination of the references does not disclose or hint at all elements of claim 8, a *prima facie* case of obviousness has not been established with respect to claim 8.

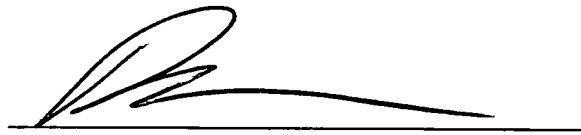
Moreover, no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of Arcens and Havinis to achieve the claimed subject matter. As clearly taught by Havinis, a distinction is made between a "positioning request" and a "page." In fact, claim 8 itself recites both a "paging message" and a "position request," which clearly indicates that these two messages are not the same. A person of ordinary skill in the art looking to the teachings of Arcens and Havinis would have been taught by Havinis that a "paging message" is different from a "positioning request." Thus, this person of ordinary skill in the art would not have been prompted to modify the teachings of Arcens and Havinis to incorporate a paging request that contains the indication recited in claim 8. Since no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of Arcens and Havinis, it is respectfully submitted that a *prima facie* case of obviousness has not been established for at least this additional reason.

Dependent claims, including newly added dependent claims 31-33, are allowable for at least the same reasons as corresponding independent claims. Moreover, in view of the allowability of base claims, it is respectfully submitted that the obviousness rejection of dependent claims have also been overcome.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0118US).

Respectfully submitted,

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